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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/645,372 | 08/21/2003 | James L. Cook | UMO 1555 | 7442 |
| 321 | 7590 | 10/05/2005 | EXAMINER | |
| SENNIGER POWERS LEAVITT AND ROEDEL ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102 | | | WILLSE, DAVID H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3738 | |

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/645,372 | | COOK ET AL. | |
| | Examiner | | Art Unit | |
| | Dave Willse | | 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9 and 14 is/are rejected.
- 7) ☒ Claim(s) 6 and 10-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 21, 2003, is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12-2-03</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3738

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ring, US 4,038,704, which discloses a humeral component 10 with a generally cylindrical spool 12 and 13 and a radioulnar component 11 comprising a body having a generally U-shaped contour (column 1, lines 32-37) with an inner peripheral surface sized and shaped for engagement and relative movement with a contoured external surface of the spool (column 1, lines 37-39; column 2, line 20; etc.). The body of the radioulnar component is configured for snap-fit attachment to the spool (column 1, lines 26-29; etc). Regarding claim 2: column 1, lines 50-54; column 2, lines 55-61; Figure 2. Regarding claim 3: column 2, lines 13-14.

Claims 8, 9, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Amis et al., US 4,242,758, which discloses a generally cylindrical spool 35 having a contoured external surface (column 6, lines 25-32) and a radioulnar component comprising a body have a generally U-shaped contour (Figures 12 and 13) with a complementary articular surface (column 7, lines 36-40). The humeral spool 35 has a bore 34 *capable* of receiving a fastener, such as the trimmed

Art Unit: 3738

end of the humerus itself (column 6, lines 22-25). Regarding claim 9, the stabilizer is viewed as the walls **53** and **55** and/or the layers of porous metal **61** (column 7, lines 19-28; Figure 11).

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ring, US 4,038,704, in view of Amis et al., US 4,242,758. Regarding claim 4, locating a pin along the anatomical center of rotation so as to engage various surgical cutting guides was well known in the art, as seen from Amis et al. (Figure 21-31 and column 9, line 51 et seq., especially column 10, lines 1-3), and would have been obvious for implanting the prosthesis of Ring, with the ordinary practitioner having been left to select an appropriate set of tools and having been motivated by the placement accuracy particularly required for snap-fit articulation surfaces. Regarding claim 7, bore receiving cavities in the spool **12** and **13** of Amis et al. would have been obvious from the minute bone receiving cavities taught by Amis et al. at column 7, lines 19-28, with motivation having been provided by the advantages cited by Amis et al. and by the perforations disclosed in Ring (column 1, lines 64-68).

Claims 6 and 10-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse
Primary Examiner
Art Unit 3738